

REMARKSStatus of the claims:

With the above amendments, claims 37-48 have been added, claims 13 and 36 have been canceled, claims 1-12, 14-19, 20, 21, 23, 25, 34, and 35 have been amended, and claims 14, 15, 22, 24, 26-33 have been withdrawn by a restriction requirement. Thus, claims 1-12, 14-19, 20-35 and 37-48 are pending with claims 1-12, 16-19, 20, 21, 23, 25, 34, 35 and 37-48 ready for further action on the merits. No new matter has been added by way of the above amendments. Claim language has been omitted by the above amendments. Moreover, new claims 37-48 have support at page 43, lines 18-21. Reconsideration is respectfully requested in light of the following remarks.

Election/Restriction

The Examiner asserts that Applicants should affirm their election.

The Examiner has required election in the present application between:

Group I: Claims 1-13, 16-19, 21, 22, 23-25, 29, 32 and 33 (all "in-part"), including compounds, compositions, methods of use, and first recited method of making, wherein W and Q are nitrogen (i.e. a purine group);

Group II: Claims 1-12, 15, 16-19, 21 and 23-25 (all "in-part"), including compounds, compositions, methods of use, and first recited method of making, wherein one of W or Q is nitrogen and the other one is carbon;

Group III: Claims 21, 23-25 and 29 (all "in-part"), including compounds, compositions, methods of use, and first recited method of making, wherein W and Q are both carbon;

Group IV: All other processes and compositions.

Applicants elect group I. However, it is respectfully pointed out that the Examiner has not examined the claims that are in group I above (as was given in the restriction requirement by telephone on April 24, 2002). In particular, the Examiner has said that claims 22, 24, 29, 32, and 33 would be examined as part of group I. However, these claims were not examined. Moreover, the Examiner has appeared to examine claims that were not a part of group I (as was given in the telephonic restriction requirement of April 24, 2002). In particular, Applicants refer to claims 20 and 34-36. Thus, Applicants confirm their election, with traverse, of Group I, claims 1-13, 16-19, 20, 21, 22, 23-25, 29, 32 and 33-36.

The basis of traversal is that the Examiner has not examined the claims that were initially indicated in the telephonic restriction requirement of April 24, 2002.

Applicants point out that claims 23, 24, 29, 32 and 33 that were not examined by the Examiner are referred to above as being "withdrawn." Claims 20 and 34-35, which were examined, are referred to as being "currently amended." Moreover, please note that claims 13 and 36 have been canceled in the present response.

Applicants respectfully request that the Examiner rejoin the method of making claims when allowable subject matter is found with the product claims in accordance with the holding in *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995).

Claim Objections

Claims 16-19 are objected to under 37 CFR §1.75 as being substantial duplicates of claim 21. Claims 16-19 have been converted into "method of use" claims. Applicants believe with these amendments, the claims are no longer substantial duplicates and the objections have been obviated. Withdrawal of the objections is warranted and respectfully requested.

Rejections under 35 USC §102

Claims 1-11, 13, 20, and 21 are rejected under 35 USC §102(a) as being anticipated by Chorvat et al. (Chorvat et al., J. Med. Chem. 42(5), pp. 833-848 (1999)).

Claims 1-11, 13, 20, and 21 are rejected under 35 USC §102(b) as being anticipated by Tangi et al. (Tangi et al., Heterocycles, 30(1), pp. 435-440, (1991)).

Claims 1-11, 13, 20, and 21 are rejected under 35 USC §102(a) as being anticipated by Young et al. (Young et al., J. Med. Chem. 33(8), pp. 2073-2080 (1990)). It is presumed that the Examiner meant 102(b).

Claims 1-11, 13, 20, and 21 are rejected under 35 USC §102(a) as being anticipated by McKenzie et al. (McKenzie et al., J. Heterocyclic Chem., 24, pp. 1551-1553, (1987)). It is presumed that the Examiner meant 102(b).

Claims 1-11, 13, 20, and 21 are rejected under 35 USC §102(a) as being anticipated by Nico et al. (Nico Kos et al., J. Org. Chem., 48(6), pp. 850-855, (1983)). It is presumed that the Examiner meant 102(b).

Claims 1-11, 13, 20, and 21 are rejected under 35 USC §102(a) as being anticipated by Bergmann et al. (Bergmann et al., Tetrahedron, 30, pp. 3045-3051, (1974)). It is presumed that the Examiner meant 102(b).

These rejections are traversed for the following reasons.

Removal of the Rejection over Chorvat et al.

Regarding Chorvat et al., the Examiner asserts that compounds having CAS registry numbers 220953-9 and 220952-86-4 (presumably the Examiner meant 220952-86-3) fall within the scope of the instant claims.

Applicants traverse. These compounds were never within the scope of the claims prior to the current amendment as they were provisoed out. Nevertheless, Applicants have amended claim 1 so to more definitively omit these compounds from the scope of claim 1. The compound of Chorvat et al. also fails to fall within the scope of claim 2 and the other claims included in the rejection. Withdrawal of the rejection is warranted and respectfully requested.

Removal of the Rejection over Tangi et al.

Regarding Tangi et al., the Examiner asserts that the compound having CAS registry number 129006-33-3 falls within the scope of the instant claims. Applicants have amended claim 1 so that this compound no longer falls within its scope. Applicants respectfully point out that this compound also does not fall within the scope of claim 2 and claims with higher numbers than claim 2. Withdrawal of the rejection is warranted and respectfully requested.

Removal of the Rejection over Young et al.

Regarding Young et al., the Examiner asserts that the compound having CAS registry number 127820-25-1 falls within the scope of the instant claims. Applicants have amended claim 1 so that this compound no longer falls within its scope. Applicants respectfully point out that this compound does not fall within the scope of claims 2 and 3 and claims with higher numbers than claim 3. Withdrawal of the rejection is warranted and respectfully requested.

Removal of the Rejection over McKenzie et al.

Regarding McKenzie et al., the Examiner asserts that the compound that is numbered 4 in the right hand column on page 1551 falls within the scope of the instant claims. Applicants have amended claim 1 so that this compound no longer falls within its scope. Applicants respectfully point out that this compound also does not fall within the scope of claim 2 and claims with higher numbers than claim 2. Withdrawal of the rejection is warranted and respectfully requested.

Removal of the Rejection over Nico Kos et al.

Regarding Nico Kos et al., the Examiner asserts that the compound 8-phenyl-9-methylpurine at page 854 right hand column

falls within the scope of the instant claims. Applicants have amended claim 1 so that this compound no longer falls within its scope. Applicants respectfully point out that this compound also does not fall within the scope of claim 2 and claims with higher numbers than claim 2. Withdrawal of the rejection is warranted and respectfully requested.

Removal of the Rejection over Bergmann et al.

Regarding Bergmann et al., the Examiner asserts that the compound numbered 5 at page 3046 falls within the scope of the instant claims (8-phenyl 9-dimethylamino purine). Applicants have amended claim 1 so that this compound no longer falls within its scope. Applicants respectfully point out that this compound also does not fall within the scope of claim 2 and claims with higher numbers than claim 2. Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 USC §112, second paragraph

Claims 1-13 have been rejected under 35 USC §112, second paragraph as being indefinite. The Examiner asserts that by reciting "a condensed imidazole compound", this renders these claims indefinite. The Examiner has recommended changing these claims to recite "a compound of formula (1), its pharmaceutically acceptable salt or hydrates thereof".

Applicants have amended the claims accordingly. Withdrawal of the rejection is warranted and respectfully requested.

The Examiner has rejected claim 20 under 35 USC §112, second paragraph as being indefinite. The Examiner asserts that the transitional language in claim 20 should be changed from "comprising" to "consisting of". Applicants disagree. Applicants respectfully point out that a receptor antagonist can have other components other than the compound recited in claim 1. Accordingly, Applicants respectfully submit that the transitional language does not need to be changed. The rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 USC §112, first paragraph

Claim 35 has been rejected under 35 USC §112, first paragraph as allegedly not being enabled. The Examiner asserts that the claim is not enabled for the language "preventing diabetic complications". Applicants traverse. Applicants submit that it is well known in the art that diabetic complications can be prevented. As proof of this, Applicants submit the attached article, The New England Journal of Medicine, 339(14), pp. 977-991 (1993), wherein it is shown that diabetic complications can be prevented. In particular, please note the Tables and Graphical Data on pages 981 and 982.

Moreover, in the instant invention, it is demonstrated that the compounds/ products of the instant invention reduce glycemia in patients to an extent that diabetic complications can be said to have been prevented. Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 USC §101

Claim 36 has been rejected under 35 USC §101 for reciting a "use" claim. Claim 36 has been canceled so the rejection is moot. Withdrawal of the rejection is warranted and respectfully requested.


With the above remarks and amendments, it is believed that the claims, as they now stand, define patentable subject matter such that passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

If any questions remain regarding the above matters, please contact Applicant's representative, T. Benjamin Schroeder (Reg. No. 50,990), in the Washington metropolitan area at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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